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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,201	03/22/2004	Bernadette Depke	092970.00002	1940

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EXAMINER	
FLANDERS, ANDREW C	
ART UNIT	**PAPER NUMBER**
2614	

MAIL DATE	DELIVERY MODE
05/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/806,201	DEPKE ET AL.	
	Examiner	Art Unit	
	ANDREW C. FLANDERS	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6 and 11-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6 and 11-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 August 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 18 March 2009 have been fully considered but they are not persuasive.

Applicant alleges:

> Applicants have modified each of the independent claims to specifically require that: a web enabled cellular telephone transmits the son identification information to a website that transfers the music to the web enabled cellular telephone.
>
> Applicants respectfully submit that none of the references of record teach or suggest the use of such a web enabled cellular telephone for the purpose of designating and downloading songs for listening via a play list. Applicants respectfully submit that it is only the instant disclosure which describes this advance in the art and provides the ability to conveniently and easily designate songs for downloading to a play list.

Examiner respectfully disagrees. As shown in the rejection below, Christensen dislcloses the device may be implemented in a cellular telephone; Col. 3 lines 40 – 41.

Additionally, the official notice taken previously was not challenged in the response the previous action, as a result, the official notice becomes admitted prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6 and 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Christensen (U.S. Patent 7,415,430).

Regarding **Claims 1 and 11**, Christensen discloses:

A system and method for downloading music (Fig. 2, which incorporates elements of Fig. 1, specifically the Automatic purchase system) comprising:

a first memory containing information designating a plurality of songs for downloading (i.e. a play list on a removable memory that is readable by a PC of which a user can access the internet for downloading; col. 6 liens 60 – 67; flash card col. 7 lines 30 – 52);

a mechanism for selectively storing song identification information in the first memory based upon a digital transmitted signal (RDS signal; APS server 144 incorporates an audio download location and information inserted into a radio station's broadcast using RBDS/RDS or similar technology; col. 5 lines 60 – 67 and col. 6 lines 1 - 8) which specifically identifies the music (audio content can be tagged for delayed purchase; col. 6; if a user elects to purchase the audio content, a request is made in

which information is presented to a server, if a connection is not available, the information can be stored on the internal flash drive; col. 6 lines 7 – 20);

further wherein the mechanism for selectively storing stores information derived from a digital signal (RDS signal) which identifies an artist and song that is played back to a system user (i.e. storing the play list as shown above; and play list information can include the song title, artist or other information; col. 5), and further wherein a web enabled cellular telephone transmits the song identification information toa website that transfers the music to the web enabled cellular telephone (in one embodiment the selected items are transmitted using a wireless transmitter 218 such as a wireless telephone).

Regarding **Claim 6**, in addition to the elements stated above regarding claim 1, Christensen further discloses:

wherein at least a portion of the system is incorporated into a radio (i.e. the device is configured to receive radio broadcasts; entire document)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 – 4 and 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen (U.S. Patent 7,415,430).

Regarding **Claims 2 – 4 and 12 – 14**, in addition to the elements stated above regarding claims 1 and 11, Christensen does not explicitly disclose:

wherein the first memory is an EEPROM, magnetic disc drive or RAM memory. However, Examiner takes official notice that EEPROM, magnetic disc drive and RAM memories are notoriously well known in the art. These memories are art recognized equivalents for the flash memory disclosed in Christensen. Substituting one of these memories would have been obvious to try to one of ordinary skill in the art given the vast knowledge on each of the different types as art recognized equivalents. Each of the various types of memories provides different features that may be preferable for someone recreating the Christensen reference. For example, size, cost, performance and other factors may be desirable for certain implementations and recreations.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW C. FLANDERS whose telephone number is (571)272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Flanders/
Patent Examiner
Art Unit 2614